



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gerald Storch et al.

Examiner: Kramer, James A.

Serial No.: 09/865,893

Group Art Unit: 3627

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet containing Certificate of Mailing (1 pg.).
- ☒ Appeal Brief to the Board of Patent Appeals and Interferences of the U.S. Patent and Trademark Office including Appendices (23 pgs.)
- ☒ Authorization to charge Deposit Account no. 500471 in the amount of \$500.00 for Appeal Brief fee.
- ☒ 1 Return Postcard.

If an additional fee is required due to changes to the claims, the fee has been calculated as follows:

CLAIMS AS AMENDED						
	(1) Claims Remaining After Amendment		(2) Highest Number Previously Paid For	(3) Present Extra	Rate	Fee
TOTAL CLAIMS	25	-	26		x =	\$0
INDEPENDENT CLAIMS	4	-	4		x =	\$
[] MULTIPLE DEPENDENT CLAIMS PRESENTED						\$
TOTAL						\$0

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate. At any time during the pendency of this application, please charge any additional fees or credit overpayment to Deposit Account No. 500471.

Customer No. 025281

By: Matthew B. McNutt
Name: Matthew B. McNutt
Reg. No.: 39,766

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop Appeal Brief Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of June, 2006.

By: Matthew B. McNutt
Name: Matthew B. McNutt



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gerald Storch et al.

Examiner: Kramer, James A.

Serial No.: 09/865,893

Group Art Unit: 3627

Filed: May 25, 2001

Docket: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

APPEAL BRIEF

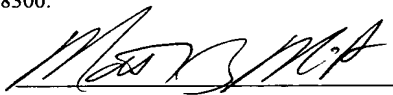
Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]

I hereby certify that this correspondence is being:

- ☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
- ☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at 571-273-8300.

June 19, 2006
Date


Signed by: Matthew B. McNutt

Dear Sir:

This is an Appeal from the Office Action mailed on December 20, 2005, finally rejecting claims 1-7, 10-24 and 30-32.

An Amendment Under 37 CFR 1.116 was mailed on March 7, 2006, traversing the final rejection of claims 1-7, 10-24 and 30-32.

An Advisory Action was mailed March 20, 2006, maintaining the finality of the rejection of claims 1-7, 10-24 and 30-32.

A Notice of Appeal in this application was mailed on April 20, 2006, and was received in the USPTO on April 25, 2006.

A Notice of Panel Decision from Pre-Appeal Brief Review was mailed on May 24, 2006.

The fee required under 37 CFR § 41.20(b)(2) for filing an Appeal Brief should be charged to Deposit Account No. 500471.

Appellants request the opportunity for a personal appearance before the Board of Appeals to argue the issues of this appeal. The fee for the personal appearance will be timely paid upon receipt of the Examiner's Answer.

06/21/2006 NNGUYEN1 00000057 500471 09865893
01 FC:1402 500.00 DA

Table of Contents

I. Real Party in Interest	3
II. Related Appeals and Interferences	3
III. Status of Claims	3
IV. Status of Amendments	3
V. Summary of the Claimed Subject Matter	3
VI. Grounds of Rejection to be Reviewed on Appeal	5
VII. Argument	6
VIII. Conclusion	16
Claims Appendix	17
Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)	22
Related Proceedings Appendix under 37 C.F.R. § 41.37 (c)(1)(ix)	23

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

I. REAL PARTY IN INTEREST

The real party in interest is Target Brands, Inc. of Minneapolis, Minnesota.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of other prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal.

III. STATUS OF CLAIMS

Claims 1-7, 10-24 and 30-32 are pending. Claims 1-7, 10-24 and 30-32 have been finally rejected and are being appealed.

IV. STATUS OF AMENDMENTS

Proposed amendments to claim 30 filed with the Amendment Under 37 CFR 1.116 mailed on March 7, 2006, were not entered because the proposed amendments were not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The Summary is set forth as an exemplary embodiment as the language corresponding to independent claims 1, 30, 31 and 32. Discussions about elements of claims 1, 30, 31 and 32 can be found at least at the cited locations in the specification and drawings.

The present invention, as claimed in independent claim 1, provides a method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site with a graphical user interface, comprising the steps of: providing members access to a co-branded Internet site including the graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer; and providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site; wherein providing members incentives comprises providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer.

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Illustrative implementations of the subject matter of claim 1 are described in the specification, e.g., at page 7, lines 13-21, page 8, lines 12-17, and Figs. 1-3.

The present invention, as claimed in independent claim 30, provides a method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site, comprising the steps of: establishing a co-branded Internet site accessible through the Internet service site of the Internet service provider, the co-branded Internet site comprising designations of both the retailer and the Internet service provider, the co-branded Internet site including one or more links to the Internet shopping site of the retailer, wherein the Internet service provider offers a news channel featuring news articles of interest to a demographic group of members; distributing at retailer locations client software for accessing the co-branded Internet site; providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site; and providing to members a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.

Illustrative implementations of the subject matter of claim 30 are described in the specification, e.g., at page 7, lines 13-21, page 9, lines 6-17, page 12, lines 5-7, and Figs. 1-3.

The present invention, as claimed in independent claim 31, provides a method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site with a graphical user interface, comprising the steps of: providing members access to a co-branded Internet site including the graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer; and providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site; wherein providing members incentives comprises providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer through the co-branded Internet site.

Illustrative implementations of the subject matter of claim 31 are described in the specification, e.g., at page 7, lines 13-21, page 8, lines 12-17, and Figs. 1-3.

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

The present invention, as claimed in independent claim 32 provides a method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site with a graphical user interface, comprising the steps of: providing members access to a co-branded Internet site including the graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer; and providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site; wherein providing members incentives comprises providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer, and further providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription to the Internet service provider.

Illustrative implementations of the subject matter of claim 32 are described in the specification, e.g., at page 7, lines 13-21, page 8, lines 1-17, and Figs. 1-3.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**VI. A. First Ground of Rejection**

Claims 1-5, 11-24 and 31 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of "American Interactive Media and Shopping.com Announce Strategic Marketing Agreement" (hereinafter AIME).

VI. B. Second Ground of Rejection

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of Staples.com.

VI. C. Third Ground of Rejection

Claim 10 stands rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of AIME, as applied to claim 1 above, and further in view of "AOL" Wal-Mart next to team on Net service" by Sandeep Junnakar (hereinafter Junnakar).

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

VI. D. Fourth Ground of Rejection

Claim 21 stands rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of OfficeDepot.com.

VI. E. Fifth Ground of Rejection

Independent claim 30 stands rejected under U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of AIME in further view of Junnakar, as applied to claim 10 above, and further in view of “IBM to sell Aptiva direct” by Joe Wilcox (hereinafter Wilcox).

VI. F. Sixth Ground of Rejection

Claim 32 stands rejected under U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of “Snafu prompts Microsoft to suspend some PC rebates” by Michael Kanellos (hereinafter Kanellos).

VII. ARGUMENT

VII.A First Ground of Rejection

Claims 1-5, 11-24 and 31 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of “American Interactive Media and Shopping.com Announce Strategic Marketing Agreement” (hereinafter AIME). Appellants assert that the rejection of claims 1-5, 11-24 and 31 under 35 USC § 103(a) should be reversed based on the following:

Under 35 U.S.C. §103, to establish a *prima facie* case of obviousness, three basic criteria must be met:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine reference teachings;
- (2) There must be reasonable expectation of success;
- (3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (F.E.D. Cir. 1991).

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Appellants respectfully submit that the combination of Tobin and AIME cannot support a case of prima facie obviousness as to the claims because, among other possible reasons, the combination of references fails to disclose all of the elements of the present invention as purported in the Final Office Action. In particular, with respect to independent claims 1 and 31, Appellants respectfully submit that Tobin and AIME, individually and in combination, fail to teach or suggest *at least* **“providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer”** (independent claim 1), and **“providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer through the co-branded Internet site”** (independent claim 31).

With regard to independent claims 1 and 31, the Final Office Action mailed December 20, 2005, acknowledges that Tobin does not specifically teach wherein providing members incentives comprises providing members with a discount on subscription fees for access to the co-branded Internet site based upon quantity of merchandise purchased from the retailer (Final Office Action, page 3, lines 4-6; page 6, lines 14-15). To overcome the acknowledged deficiency of Tobin, the Final Office Action cites AIME as teaching accumulation of “Maximizer Dollars” based on a quantity of merchandise purchased from Shopping.com and redeemable for discounted or free internet access (Final Office Action, page 3, lines 7-10; page 6, lines 14-15). The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the incentives as allegedly taught by Tobin to include discounted or free Internet service based on quantity of merchandise purchased as allegedly taught by AIME (Final Office Action, page 3, lines 11-15; page 6, lines 14-15).

However, Appellants submit that **AIME is completely silent and provides absolutely no teaching or suggestion regarding how “Maximizer Dollars” may be accumulated.** The teachings of AIME regarding discounted or free Internet access are limited to a single statement that “Benefits include no set up fees, and the ability to accumulate and redeem ‘Maximizer Dollars’ for discounted or free internet access.” There is simply no teaching or suggestion in AIME that accumulation of “Maximizer Dollars” are related to a quantity of merchandise purchased from the retailer. The noted deficiencies of AIME were set forth in the Amendment Under 37 CFR 1.116 mailed on March 7, 2006. In response, the Advisory Action mailed March 20, 2006, introduced a *new reference* (i.e.,

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

“Shopping.com Announces the Grand Opening of the Internet’s First Full Service Retail Destination Hub Site”) as teaching that Maximizer Dollars taught in AIME are inherently accumulated based on the purchase of products and/or services from Shopping.com (Advisory Action, page 2, lines 7-13).

Contrary to the Examiner’s position, Appellants submit that Maximizer Dollars as taught in AIME are *not* inherently accumulated based on the purchase of products and/or services from Shopping.com. **There are any number of possible ways that Maximizer Dollars may be accumulated other than by the purchase of products or services (e.g., signing up additional members, as rewards for clicking on banner advertisements on the site, etc.) such that accumulation based on the purchase of products or services is not inherent in AIME**, as suggested by the Examiner. Indeed, Appellants submit that the introduction of a *new reference* supports Appellants’ position that AIME fails to teach accumulation of Maximizer Dollars based on a quantity of merchandised purchased. Appellants further submit that the introduction of the *new reference* requires withdrawal of the finality of the Office Action and issuance of a new non-final action.

For at least the reasons provided above, the combination of Tobin and AIME cannot support a 35 U.S.C. 103(a) rejection of independent claims 1 and 31, and withdrawal of the rejection is respectfully requested.

Dependent claims 2-5 and 11-24 depend directly or indirectly from independent claim 1 which is not obvious over Tobin in view of AIME for at least the reasons provided above. Accordingly, dependent claims 2-5 and 11-24 are also not obvious over Tobin in view of AIME at least by reason of their dependency from claim 1. Therefore, withdrawal of the rejection of claims 2-5 and 11-24 under 35 U.S.C. 103(a) is also respectfully requested.

VII.B Second Ground of Rejection

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of Staples.com. Appellants assert that the rejection of claims 6 and 7 under 35 USC § 103(a) should be reversed based on the following:

With respect to claim 6, the Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 6 except wherein providing members incentives comprises providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

corresponding printed advertising circulars are distributed (Final Office Action, page 7, lines 3-6). To overcome the acknowledged deficiencies of Tobin as modified by AIME, the Final Office Action cites Staples.com as allegedly teaching providing advertising circulars on the Internet prior to distributing the printed versions (Final Office Action, page 7, lines 7-8). The Final Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tobin to include providing users with electronic versions of advertising circulars prior to distributing the printed versions as taught by Staples.com in order to drive traffic to the site (Final Office Action, page 7, lines 10-13).

Claim 6 depends directly from independent claim 1, which is not obvious over Tobin in view of AIME for at least the reasons set forth above. Staples.com does not overcome the noted deficiencies of the Tobin/AIME combination, in that Staples.com makes no teaching regarding “providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer.” Accordingly, dependent claim 6 is also not obvious in view of the art of record.

In addition, contrary to the characterization of Staples.com set forth in the Final Office Action, Appellants’ submit that **Staples.com fails to teach or suggest “providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printed advertising circulars are distributed.”** There is no teaching or suggestion in Staples.com that the “Staples Specials for 2/29/00” are in any way related to printed advertising circular content. Even if the “Staples Specials for 2/29/00” was related to printed advertising circular content, there is no teaching that the information as presented on the Internet shopping site is available **before corresponding printed advertising circulars are distributed**, as is set forth in claim 6. Rather, it is only Appellants’ disclosure that teaches providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printed advertising circulars are distributed.

In the Advisory Action mailed March 20, 2006, the Examiner asserts that one of ordinary skill in the art would recognize the “specials” of Staples.com “as content that would/could be contained in a circular and as such it clearly represents circular content.” (Advisory Action, page 2, lines 17-19). However, even the questionable assertion that content that “would/could be contained in a circular ... clearly represents circular content” fails to teach or suggest that the information as presented on the Internet shopping site is available **before corresponding printed advertising circulars are distributed**, as is set

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

forth in claim 6. In the Advisory Action, the Examiner further asserts that “distribution of circulars is most commonly done at the store” and therefore “any user who logs on to the website prior to going to the store would clearly receive the circular content prior to having the corresponding printed advertising circular distributed to them (Advisory Action, page 3, lines 2-4). However, claim 6 sets forth “providing members with **access** to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printed advertising circulars are distributed.” Providing access to circular content before the printed circulars are distributed (as set forth in claim 6) is different than the Examiner’s erroneous claim construction which implies a member does not have access to circular content until the member actually views the circular content. Clearly, having *access* to circular content does not require a member to actually view or obtain the content.

For at least the reasons provided above, the combination of Tobin, AIME and Staples.com cannot support a 35 U.S.C. 103(a) rejection of claim 6, and withdrawal of the rejection is respectfully requested.

With respect to claim 7, the Final Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 7 except wherein providing members incentives comprises providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members (Final Office Action, page 7, lines 14-18). To overcome the acknowledged deficiencies of Tobin, the Office Action cites Staples.com as allegedly teaching publishing to registered users (members) “News and Hot Offers” before publishing to non-registered users (non-members) (Final Office Action, page 7, line 19 through page 8, line 2). The Final Office Action alleges that “News and Hot Product Offers” represents Appellants’ claimed “notice of store-based clearances, promotional events and/or special events” and concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tobin to provide registered users with “News and Hot Product Offers” notices before non-registered users as taught by Staples.com. (Final Office Action, page 8, lines 2-6).

Claim 7 depends directly from independent claim 1, which is not obvious over Tobin in view of AIME for at least the reasons set forth above. Staples.com does not overcome the noted deficiencies of the Tobin/AIME combination, in that Staples.com makes no teaching regarding “providing the members with a discount on subscription fees for access to the co-

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

branded Internet site based upon a quantity of merchandise purchased from the retailer.”

Accordingly, dependent claim 7 is also not obvious in view of the art of record.

In addition, contrary to the characterization of Staples.com set forth in the Final Office Action, Appellants’ submit that **Staples.com fails to teach or suggest “providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members.”** There is no teaching or suggestion in Staples.com that the “News and Hot Product Offers” are provided to one class of users (i.e., members) before being provided to another class of users (i.e., non-members). In the Advisory Action mailed March 20, 2006, the Examiner asserts that “the hot news items provided by email are not distributed to a user unless he becomes a ‘member’, as such they inherently must be given to members before non-members (since they are never given to non-members).” (Advisory Action, page 3, lines 5-9). However, the entering of an e-mail address simply allows a user to receive the “News and Hot Product Offers” in a different manner (i.e., via e-mail, rather than visiting the retailer’s web site). There is no teaching or suggestion, and it is certainly not inherent, that the e-mail recipients in Staples.com receive the news and product offers before the news and product offers are offered on the web site, or that such offers are not made available to all visitors to the web site. It is only Appellants’ disclosure that teaches providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members.

For at least the reasons provided above, the combination of Tobin, AIME and Staples.com cannot support a 35 U.S.C. 103(a) rejection of claim 7, and withdrawal of the rejection is respectfully requested.

VII.C Third Ground of Rejection

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of AIME, as applied to claim 1 above, and further in view of “AOL” Wal-Mart next to team on Net service” by Sandeep Junnakar (hereinafter Junnakar). Appellants assert that the rejection of claim 10 under 35 USC § 103(a) should be reversed based on the following:

The Final Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 10 except wherein the retailer operates retail stores and the method further comprises distributing software for the co-branded Internet site at the retail stores (Final Office Action, page 8, lines 10-13). To overcome the

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

acknowledged deficiencies of Tobin, the Final Office Action cites Junnakar as allegedly teaching a co-branded website between ISP AOL and retailer Wal-Mart including the distribution of software at the retail establishment (Final Office Action, page 8, lines 14-16). The Final Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention modify the teachings of Tobin to include a retailer such as Walmart and to distribute software at the retail location as taught by Junnakar (Final Office Action, page 8, lines 17-21).

Claim 10 depends directly from independent claim 1, which is not obvious over Tobin in view of AIME for at least the reasons set forth above. Junnakar does not overcome the noted deficiencies of the Tobin/AIME combination, in that Junnakar makes no teaching regarding “providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer.” Accordingly, dependent claim 10 is also not obvious in view of the art of record.

For at least the reasons provided above, the combination of Tobin, AIME and Junnakar cannot support a 35 U.S.C. 103(a) rejection of claim 10, and withdrawal of the rejection is respectfully requested.

VII.D Fourth Ground of Rejection

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of OfficeDepot.com. Appellants assert that the rejection of claim 21 under 35 USC § 103(a) should be reversed based on the following:

The Final Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 21 except including a link to an application for a proprietary credit card issued by the retailer (Final Office Action, page 9, lines 3-5). To overcome the acknowledged deficiencies of Tobin, the Final Office Action cites OfficeDepot.com as teaching including on a website a link to an Application for an Office Depot Credit card (Final Office Action, page 9, lines 6-8). The Final Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the co-branded website of Tobin to include a like to an application for a proprietary credit card issued by the retailer as taught by OfficeDepot.com (Final Office Action, page 9, lines 9-13).

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Claim 21 depends directly from independent claim 1, which is not obvious over Tobin in view of AIME for at least the reasons set forth above. OfficeDepot.com does not overcome the noted deficiencies of the Tobin/AIME combination, in that OfficeDepot.com makes no teaching regarding “providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer.” Accordingly, dependent claim 21 is also not obvious in view of the art of record.

For at least the reasons provided above, the combination of Tobin, AIME and OfficeDepot.com cannot support a 35 U.S.C. 103(a) rejection of claim 10, and withdrawal of the rejection is respectfully requested.

VII.E Fifth Ground of Rejection

Independent claim 30 stands rejected under U.S.C. §103(a) as being unpatentable over Tobin in view of AIME in further view of Junnakar, as applied to claim 10 above, and further in view of “IBM to sell Aptiva direct” by Joe Wilcox (hereinafter Wilcox). Appellants assert that the rejection of claim 30 under 35 USC § 103(a) should be reversed based on the following:

The Final Office Action alleges that the combination of Tobin in view of AIME and in further view of Junnakar, as described above, teaches all the limitations of claim 30 except providing to members a link to news articles and a link to a page on the Internet shopping site offering for sale a product featured in the news article (Final Office Action, page 9, lines 17-20). To overcome the acknowledged deficiencies of Tobin, AIME and Junnakar, the Final Office Action cites Wilcox as evidence that prior to Appellants’ invention it was old and well known to include within news articles links to product pages that sell the products featured in the article (Final Office Action, page 10, lines 1-3). The Office Action further alleges that Tobin teaches links to news articles (Final Office Action, page 10, lines 3-4). The Final Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the news articles of Tobin to include links to product pages to buy the products featured in the articles as taught by Wilcox (Final Office Action, page 10, lines 4-8).

Appellants submit that the cited references, individually and in combination, fail to teach or suggest *at least* **“providing to members a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news**

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

article.” Although Tobin teaches links to news articles (e.g., as in Fig. 11A), the links in Tobin are links having *disparate* content (e.g., “Money Personal Finance”; “Sports”; “Techwatch” as shown in Fig. 11A of Tobin). Wilcox teaches news articles having embedded links to product pages that sell the products featured in the article. However, in Wilcox, a user can only access the link to a page offering for sale a product featured in the news article after accessing the news article. That is, Wilcox teaches “serial” access to the links. The user is not provided **a link to a news article and a link to a page offering for sale a product featured in the news article**. AIME and Junnakar both fail to remedy the deficiencies of Tobin and Wilcox, as neither AIME nor Junnakar teach or suggest providing a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.

For at least the reasons provided above, the combination of Tobin, AIME, Junnakar, and Wilcox cannot support a 35 U.S.C. 103(a) rejection of claim 30, and withdrawal of the rejection is respectfully requested.

VII.F Sixth Ground of Rejection

Claim 32 stands rejected under U.S.C. §103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of “Snafu prompts Microsoft to suspend some PC rebates” by Michael Kanellos (hereinafter Kanellos). Appellants assert that the rejection of claim 32 under 35 USC § 103(a) should be reversed based on the following:

The Final Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 32 except providing members with a discount on merchandise purchased wherein the rate of merchandise discount and period of time of which the discount is available varies on the basis of the length of member’s subscription to the Internet service provider (Final Office Action, page 10, lines 12-16). To overcome the acknowledged deficiencies of Tobin, the Office Action cites Kanellos as allegedly teaching that at the time of the Appellants’ invention it was well known for Internet service providers to give customers discounts on products at affiliated retail stores based on the length of the customer’s subscription to the Internet service provider (Final Office Action, page 10, lines 17-19). In the specific case of Kanellos, customers that agreed to a 3 year subscription were given a \$400 rebate to an affiliated retail store. The Final Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

the invention modify the teachings of Tobin to include providing a discount at PC Flowers (affiliated retailer) based on a length of subscription to an ISP as taught by Kanellos (Final Office Action, page 11, lines 3-7).

Appellants' submit that Tobin, AIME and Kanellos, individually and in combination, fail to teach or suggest all the limitations of independent claim 32. In particular, Tobin, AIME and Kanellos fail to teach or suggest *at least* **“providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer, and further providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member’s subscription to the Internet service provider.”**

As discussed above with regard to independent claim 1, Tobin and AIME fail to teach or suggest “providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer.” The remarks made with regard to independent claim 1 are equally applicable to independent claim 32. That is, as acknowledged in the Final Office Action, Tobin fails to teach providing members with a discount on subscription fees for access to the co-branded Internet site based upon quantity of merchandise purchased from the retailer. In addition, there is no teaching or suggestion in AIME that providing members with incentives comprises providing the members with a discount on subscription fees for access to the recited co-branded Internet site based upon a quantity of merchandise purchased from the retailer.

As noted above, the Final Office Action acknowledges that Tobin and AIME fail to teach or suggest “providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member’s subscription to the Internet service provider,” and cites Kanellos as remedying this deficiency. Contrary to the characterization of Kanellos set forth in the Final Office Action, Kanellos does not teach or suggest a rate of the merchandise discount varies on the basis of the length of a member’s subscription, and further does not teach or suggest a period of time over which the merchandise discount is available varies on the basis of the length of a member’s subscription. Rather, **the rate of merchandise discount in Kanellos is dependent upon the product purchased (i.e., buy a**

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

three year subscription and receive a \$400 discount), **and does not vary on the basis of the length of a member's subscription** to the Internet service provider. Further, there is no teaching or suggestion that the rate of merchandise discount *varies* even on the basis of the product purchased, much less the length of a member's subscription. Finally, Kanellos makes no teaching regarding *how long* the discount is available. The only mention of a time period in Kanellos is with respect to the product purchased (i.e., a three year subscription). Thus, Kanellos cannot be said to teach or suggest that the period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription. Rather, it is only Appellants' disclosure that teaches "providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription to the Internet service provider"

For at least the reasons provided above, the combination of Tobin, AIME, Junnakar, and Wilcox cannot support a 35 U.S.C. 103(a) rejection of claim 32, and withdrawal of the rejection is respectfully requested.

VIII. CONCLUSION

For the foregoing reasons, appellants respectfully submit that the Examiner has erred in rejecting this application. Please reverse the Examiner on all counts.

Any inquiry regarding this Appeal should be directed to either William M. Hienz, III at Telephone No. (612) 696-0109, or Matthew B. McNutt at Telephone No. (612) 767-2510, Facsimile No. (612) 573-2005.

Respectfully submitted,

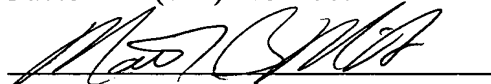
Gerald Storch et al.,

By their attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2000
Facsimile: (612) 573-2005

Date: June 19, 2006

MBM:imv



Matthew B. McNutt

Reg. No. 39,766

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

CLAIMS APPENDIX

1. (Previously Presented) A method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site with a graphical user interface, comprising the steps of:

providing members access to a co-branded Internet site including the graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer; and

providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site;

wherein providing members incentives comprises providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer.

2. (Original) The method of claim 1 wherein providing the co-branded Internet site includes providing a link to the Internet shopping site on all pages of the Internet service site.

3. (Original) The method of claim 1 comprising providing the link to the Internet shopping site with icons comprising one or more trademark logos of the retailer.

4. (Previously Presented) The method of claim 1 wherein the graphical user interface of the co-branded Internet site includes a tool bar; and the method further comprises locating a link to the Internet shopping site on the tool bar.

5. (Original) The method of claim 1 wherein providing members incentives includes providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site.

6. (Previously Presented) The method of claim 1 wherein providing members incentives comprises providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printed advertising circulars are distributed.

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

7. (Previously Presented) The method of claim 1 wherein providing members incentives comprises providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members.

8. (Canceled)

9. (Canceled)

10. (Previously Presented) The method of claim 1 wherein the retailer operates retail stores and the method further comprises distributing software for the co-branded Internet site at the retail stores.

11. (Original) The method of claim 1 comprising distributing software for the co-branded Internet site on the Internet shopping site.

12. (Original) The method of claim 1 comprising distributing software for the co-branded Internet site on the Internet service site of the Internet service provider.

13. (Previously Presented) The method of claim 1 comprising co-branding software for accessing the co-branded Internet site with designations of the retailer and the Internet service provider.

14. (Previously Presented) The method of claim 1 comprising co-branding software for accessing the co-branded Internet site.

15. (Previously Presented) The method of claim 1 comprising advertising the co-branded Internet site on the Internet service site of the Internet service provider.

16. (Previously Presented) The method of claim 1 comprising:
providing the co-branded Internet site with a tool bar having a link to a menu list of a member's regularly used links; and
including an icon on the tool bar that is linked to the Internet shopping site.

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

17. (Previously Presented) The method of claim 16 wherein the icon comprises one or more logos of the retailer.

18. (Original) The method of claim 1 comprising providing the co-branded Internet site with retailer channel links to ISP channel page content of interest to one or more demographic groups of members.

19. (Original) The method of claim 1 comprising providing the Internet shopping site with retailer channel links to ISP channel page content of interest to one or more demographic groups of members.

20. (Original) The method of claim 19 comprising providing the Internet shopping site with retailer channel links to non-ISP channel page content.

21. (Previously Presented) The method of claim 1 wherein the co-branded Internet site includes a link to an application for a proprietary credit card issued by the retailer.

22. (Previously Presented) The method of claim 1 comprising providing the co-branded Internet site with links to departments within stores operated by the retailer.

23. (Original) The method of claim 22 wherein the links to the departments at the stores include order requests.

24. (Original) The method of claim 1 comprising providing the co-branded Internet site with links to affiliates of the retailer.

25-29. (Canceled)

30. (Currently Amended) A method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site, comprising the steps of:

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

establishing a co-branded Internet site accessible through the Internet service site of the Internet service provider, the co-branded Internet site comprising designations of both the retailer and the Internet service provider, the co-branded Internet site including one or more links to the Internet shopping site of the retailer, wherein the Internet service provider offers a news channel featuring news articles of interest to a demographic group of members;

distributing at retailer locations client software for accessing the co-branded Internet site;

providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site; and

providing to members a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.

31. (Previously Presented) A method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site with a graphical user interface, comprising the steps of:

providing members access to a co-branded Internet site including the graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer; and

providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site;

wherein providing members incentives comprises providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer through the co-branded Internet site.

32. (Previously Presented) A method for a retailer of the type having an Internet shopping site to sell merchandise over the Internet in affiliation with an Internet service provider of the type having an Internet service site with a graphical user interface, comprising the steps of:

providing members access to a co-branded Internet site including the graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer; and

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site;

wherein providing members incentives comprises providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer, and further providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription to the Internet service provider.

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Appeal Brief

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.